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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 036910-0114	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>On December 26, 2007</p> <p>Signature _____</p> <p>Typed or printed name _____</p>	Application Number 10/534,760		Filed 11/12/2003
	First Named Inventor Hideyuki KOBAYASHI		
	Art Unit 2617		Examiner N. Mehrpour
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>26,874</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</p>			

*Thomas J. Ellis* *Res. No. 43,438*  
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December 26, 2007  
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Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Atty. Dkt. No. 036910-0114

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Hideyuki KOBAYASHI et al.  
Title: CHARGING METHOD FOR USE IN  
SERVICE PROVIDING SYSTEM,  
PROGRAM, AND STORAGE  
MEDIUM  
Appl. No.: 10/534,760  
International Filing Date: 11/12/2003  
371(c) Date: 5/13/2005  
Examiner: N. Mehrpour  
Art Unit: 2617  
Confirmation Number: 7036

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

***Rejections under 35 U.S.C. § 103***

Claims 1-6, 8-26 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,751,454 to Thornton ("Thornton") in view of U.S. Publication 2003/0233278 to Marshall ("Marshall"). Claims 7 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thornton in view of U.S. Publication 2005/0046584 to Breed ("Breed"). Applicants respectfully traverse these rejections for at least the following reasons.

**Independent claims 1 and 14**

Independent claim 1 recites "wherein the first terminal device is arranged such that the first terminal device cannot be directly operated by the user", and "a step of the first terminal device detecting a change in state of an object to be monitored, and operating according to a detected state of

the object, wherein the modified predetermined parameter determines an operation that is performed by the first terminal device according to the state detected by the first terminal device.” The references applied in the rejections of the claims fail to disclose at least these features in the context of claim 1.

For example, Thornton does not disclose “wherein the first terminal device is arranged such that the first terminal device cannot be directly operated by the user” as in claim 1. Rather, Thornton discloses that a user directly operates a terminal device. Thus, Thornton does not intend to transmit any modification command to a terminal device provided in a state that it cannot be directly operated by the user.

The Patent Office cites to col. 7, lines 9-28 of Thornton as allegedly disclosing “wherein the first terminal device is arranged such that the first terminal device cannot be directly operated by the user.” The cited section of Thornton, however, merely discloses details of a wireless consumer (who uses a wireless communication device 32) selecting and listening to audio items, but says nothing about a terminal device provided in a state that it cannot be directly operated by the user.

Thornton also does not disclose “a step of the first terminal device detecting a change in state of an object to be monitored, and operating according to a detected state of the object, wherein the modified predetermined parameter determines an operation that is performed by the first terminal device according to the state detected by the first terminal device” as recited in claim 1. Rather, Thornton merely discloses that upon receiving an instruction/command from an external entity, the terminal device performs an operation according to the instruction/command, and fails to disclose that the terminal device detects changes in state of an object to be monitored and performs an operation according to the detected state.

The Patent Office now relies on Marshall for allegedly disclosing “a step of the first terminal device detecting a change in state of an object to be monitored, and operating according to a detected state of the object, wherein the modified predetermined parameter determines an operation that is performed by the first terminal device according to the state detected by the first terminal device” in paragraph [0037] of the Marshall disclosure. The cited section of Marshall, however, merely deals with identity theft, and services offered by companies related to such theft. The cited section of Marshall has nothing to do with “a step of the first terminal device detecting a change in state of an object to be monitored, and operating according to a detected state of the object, wherein the modified predetermined parameter determines an operation that is performed by the first terminal device according to the state detected by the first terminal device” as recited in claim 1.

Independent claim 14 recites features corresponding to those discussed above with respect to claim 1, and is thus patentable for reasons analogous to claim 1.

### **Independent claims 23 and 26**

Independent claim 23 recites “a step of the first terminal device detecting a change in state of an object to be monitored, and operating according to a detected state of the object, wherein the modified predetermined parameter determines an operation that is performed by the first terminal device according to the state detected by the first terminal device” and is patentable for reasons analogous to those discussed above with respect to this feature.

Independent claim 23 further recites “(IV) a step of the first terminal device performing an operation determined in accordance with the modified predetermined parameter, among a plurality of operations which are respectively associated with possible detected states of the object to be monitored and which are to be performed when the state of the object to be monitored has changed”, which feature is not suggested by the references applied in the context of claim 23.

For example, Thornton does not disclose “a step of the first terminal device performing an operation determined in accordance with the modified predetermined parameter, among a plurality of operations which are respectively associated with possible detected states of the object to be monitored and which are to be performed when the state of the object to be monitored has changed” as in claim 23. Rather, in Thornton, the terminal device can perform only the same operation according to the instructions from a center. To the contrary, in the presently claimed invention of claim 23, in response to the change in state of the object to be monitored, the terminal device can select an operation that is different from a previous operation, from among plural kinds of operations in accordance with a parameter, and then perform the selected operation.

Moreover, nowhere does the Patent Office assert that any of the references applied in the rejection of the claims disclose “a step of the first terminal device performing an operation determined in accordance with the modified predetermined parameter, among a plurality of operations which are respectively associated with possible detected states of the object to be monitored and which are to be performed when the state of the object to be monitored has changed” as recited in claim 23. The Patent Office **fails to point to any section** of Thornton, Marshall or Breed, as disclosing this feature of claim 23.

Independent claim 26 recites features corresponding to those discussed above with respect to claim 23, and is thus patentable for reasons analogous to claim 23.

### **Independent claim 29**

Independent claim 29 recites “a step of the first terminal device detecting a change in state of the object to be monitored, and operating according to a detected state of the object, wherein the modified predetermined parameter determines an operation that is performed by the first terminal device according to the state detected by the first terminal device.” As discussed above with respect to independent claims 1 and 14, Thornton does not suggest this feature.

Moreover, claim 29 recites “a step of the second terminal device presenting plural operations to be performed by the first terminal device according to a detected state of an object to be monitored, so that the user can select an operation from among the presented operations, and the second terminal device accepting the operation selected by the user”, which feature is not suggested by the references applied in the context of claim 29.

For example, Thornton does not disclose “the second terminal device presenting plural operations to be performed by the first terminal device according to a detected state of an object to be monitored, so that the user can select an operation from among the presented operations, and the second terminal device accepting the operation selected by the user.” Thornton does not disclose any second terminal that presents operations to be performed by a first terminal device so that the user can select an operation, and the second terminal accepts the selected operation.

Moreover, nowhere does the Patent Office assert that any of the references applied in the rejection of the claims disclose “a step of the second terminal device presenting plural operations to be performed by the first terminal device according to a detected state of an object to be monitored, so that the user can select an operation from among the presented operations, and the second terminal device accepting the operation selected by the user” as recited in claim 29. The Patent Office **fails to point to any section** of Thornton, Marshall or Breed, as disclosing this feature of claim 29.

Marshall and Breed fail to cure the deficiencies of Thornton.

The dependent claims are patentable for at least the same reasons as their respective independent claims as well as for further patentable features recited therein. For example, new dependent claims 25, 28 and 30 recite “wherein the first terminal device is configured to control a device to be controlled, wherein the device to be controlled is installed in the object to be monitored.” By contrast, in Thornton, the terminal device performs only an independent operation that is completed in the terminal device, such as reproduction of music. In contrast to claims 25, 28 and 30, the terminal device of Thornton does not control various devices to be controlled, so that the devices to be controlled can perform operations.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date

December 29, 2007

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